

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-16, 24-29, and 34-40 are currently pending. Claims 1, 11, 24, and 39 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.¹

In the outstanding Office Action, Claims 1, 2, 4, 6, 11, 12, 14, 24, 26, 27, and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP Patent Application Publication No. 2001-270194 to Kobayashi in view of U.S. Patent No. 7,164,486 to Nakamura et al. (hereinafter “Nakamura”); Claims 3, 5, 7, 16, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Nakamura and JP Patent Application Publication No. 2001-217972 to Kajita; Claims 9 and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Nakamura and U.S. Patent No. 5,892,595 to Yamakawa et al. (hereinafter “Yamakawa”); Claims 8, 15, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobaysashi in view of Nakamura and U.S. Patent Application Publication No. 2002/0036643 to Namizuka et al. (hereinafter “Namizuka ‘643”); Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Nakamura, Namizuka ‘643, and U.S. Patent Application Publication No. 2001/0019429 to Oteki et al. (hereinafter “Oteki”); Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Nakamura and U.S. Patent Application Publication No. 2001/0015821 to Namizuka et al. (hereinafter “Namizuka ‘821”); and Claims 34-38 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Nakamura and U.S. Patent Application Publication No. 2002/0156704 to Kolls.

¹ See, e.g., page 12, lines 20 and 21; and page 13, lines 17-28 of the originally filed specification.

REJECTION UNDER 35 U.S.C. § 103

Amended Claim 1 is directed to an image forming apparatus, comprising:

an image reading device configured to read an image of an original document;

an image forming device configured to form an image on a sheet in accordance with image data read by the image reading device;

an operation unit connecting device configured to detachably connect an operation unit, said operation unit being configured to accept inputting of operational instructions for operating the image forming apparatus and to connect to the image forming apparatus via the operation unit connecting device;

a process controller configured to control an operation of at least one of the image reading device and the image forming device; and

an expansion unit connecting device configured to connect an additionally attachable expansion unit, said additionally attachable expansion unit including an expansion control device and being configured to further connect to the operation unit detached from the image forming apparatus, wherein

said additionally attachable expansion unit connects to the image forming apparatus via the expansion unit connecting device,

while the additionally attachable expansion unit is determined to be connected to the expansion unit connecting device, the expansion control device controls the at least one of the image reading device and the image forming device,

only the expansion control device controls the operation of the image reading device and the image forming device when the additionally attachable expansion unit, which includes the expansion control device, is connected to the expansion unit connecting device, and

when the additionally attachable expansion unit is not connected to the expansion unit connecting device, said process controller controls one of the image reading device and the image forming device to operate based on the operational instructions inputted to the operation unit.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the Office Action acknowledges, and it is respectfully submitted, that Kobayashi “fails to specifically teach the expansion control device controls the at least one of the image reading device and the image forming device.”² Rather, the Office Action cites Nakamura for such a teaching. Thus, it is respectfully submitted that Kobayashi fails to disclose only the expansion control device controls the operation of the image reading device and the image forming device when the additionally attachable expansion unit, which includes the expansion control device, is connected to the expansion unit connecting device, as now defined in Claim 1.

Further, it is respectfully submitted that Nakamura fails to remedy the deficiencies of Kobayashi, as discussed above. Nakamura is directed to an image forming apparatus which carries out complex functions which make it possible to connect it to a plurality of external apparatuses. In particular, the Office Action cites the Nakamura CPU 51 included in an expansion box 50 for teaching “the expansion control device controls the at least one of the image reading device and the image forming device.”³

However, it is respectfully submitted that Nakamura fails to disclose only the expansion control device controls the operation of the image reading device and the image forming device when the additionally attachable expansion unit, which includes the expansion control device, is connected to the expansion unit connecting device. Rather, Nakamura discusses two copying manipulations are offered on the image editing system 100. Nakamura discusses that one is the copying instruction through the operation panel 15 mounted on the image forming apparatus 10 and the other is the copying instructions performed with the use of the large screen display 71 of the expansion box 50 side.⁴ Further, Nakamura discusses priority is given to the display 71 on the expansion box 50 to prohibit

² See Office Action dated December 14, 2009, page 6.

³ Id.

⁴ See Nakamura, column 20, lines 34-39.

simultaneous manipulation.⁵ That is, Nakamura discusses that **both the image forming apparatus 10 and the expansion box 50 have control over copying operations.** Nakamura does not disclose that only the *expansion box 50 (i.e., the asserted expansion control device)* controls the operation of an image reading device and an image forming device of the image forming apparatus.

Thus, no matter how the teachings of Kobayashi and Nakamura are combined, the combination does not teach or suggest the expansion control device of Claim 1. Accordingly, it is respectfully submitted that independent Claim 1 (and all associated dependent claims) patentably defines over any proper combination of Kobayashi and Nakamura.

Amended Claim 11 recites limitations analogous to the limitations recited in Claim 1. Further, Claim 11 has been amended in a manner analogous to the amendments to Claim 1. Accordingly, for reasons analogous to the reasons stated above for the patentability of Claim 1, it is respectfully submitted that independent Claim 11 (and all associated dependent claims) patentably defines over any proper combination of Kobayashi and Nakamura.

Amended Claim 24 recites, *inter alia*,

while the additionally attachable expansion unit is determined to be connected to the expansion unit connecting device, controlling by the expansion control device the at least one of the image reading device and the image forming device, wherein

only the expansion control device controls the operation of the image reading device and the image forming device when the additionally attachable expansion unit, which includes the expansion control device, is connected to the expansion unit connecting device.

Amended Claim 39 recites, *inter alia*,

only the expansion control device controls the operation of the image reading device and the image forming device when the expansion unit is connected to the image forming apparatus.

⁵ See Nakamura, column 18, lines 17 and 18.

As noted above, Kobayashi and Nakamura, alone or in proper combination, fail to disclose the expansion control device of Claim 1. Thus, Kobayashi and Nakamura fail to disclose the controlling by the expansion control device step and the expansion control device of Claims 24 and 39, respectively. Accordingly, it is respectfully submitted that Claims 24 and 39 (and all associated dependent claims) patentably define over any proper combination of Kobayashi and Nakamura.

Regarding the rejections of dependent Claims 3, 5, 7, 16, and 25 under 35 U.S.C. § 103(a), it is respectfully submitted that Kajita fails to remedy the deficiencies of Kobayashi and Nakamura, as discussed above. Accordingly, it is respectfully submitted that dependent Claims 3, 5, 7, 16, and 25 patentably define over any proper combination of Kobayashi, Nakamura, and Kajita.

Regarding the rejections of dependent Claims 9 and 29 under 35 U.S.C. § 103(a), it is respectfully submitted that Yamakawa fails to remedy the deficiencies of Kobayashi and Nakamura, as discussed above. Accordingly, it is respectfully submitted that dependent Claims 9 and 29 patentably define over any proper combination of Kobayashi, Nakamura, and Yamakawa.

Regarding the rejections of dependent Claims 8, 15, and 28 under 35 U.S.C. § 103(a), it is respectfully submitted that Namizuka '643 fails to remedy the deficiencies of Kobayashi and Nakamura, as discussed above. Accordingly, it is respectfully submitted that dependent Claims 8, 15, and 28 patentably define over any proper combination of Kobayashi, Nakamura, and Namizuka '643.

Regarding the rejection of dependent Claim 10 under 35 U.S.C. § 103(a), it is respectfully submitted that Oteki fails to remedy the deficiencies of Kobayashi and Nakamura, as discussed above. Accordingly, it is respectfully submitted that dependent

Claim 10 patentably defines over any proper combination of Kobayashi, Nakamura, and Oteki.

Regarding the rejection of dependent Claim 13 under 35 U.S.C. § 103(a), it is respectfully submitted that Namizuka '821 fails to remedy the deficiencies of Kobayashi and Nakamura, as discussed above. Accordingly, it is respectfully submitted that dependent Claim 13 patentably defines over any proper combination of Kobayashi, Nakamura, and Namizuka '821.

Regarding the rejections of dependent Claims 34-38 and 40 under 35 U.S.C. § 103(a), it is respectfully submitted that Kolls fails to remedy the deficiencies of Kobayashi and Nakamura, as discussed above. Accordingly, it is respectfully submitted that dependent Claims 34-38 and 40 patentably define over any proper combination of Kobayashi, Nakamura, and Kolls.

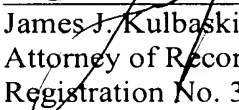
CONCLUSION

Thus, it is respectfully submitted that independent Claims 1, 11, 24, and 39 (and all associated dependent claims) patentably define over Kobayashi, Nakamura, Kajita, Yamakawa, Namizuka '643, Oteki, Namizuka '821, and Kolls.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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